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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,524	10/10/2001	Christopher R. Vincent	POU920010113US1	1514

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EXAMINER	
BADII, BEHRANG	
ART UNIT	**PAPER NUMBER**
3621	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/976,524	VINCENT, CHRISTOPHER R.	
	Examiner	Art Unit	
	Behrang Badii	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-9,16-20,27-31 and 34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-9,16-20,27-31 and 34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Arguments

Applicant's arguments with respect to claim 5-9, 16-20, 27-31 and 34 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5, 16 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear to a person of ordinary skill in the art to discern how one would determine that the nonce value is valid and has been accepted for fewer than the limited number of requests.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 16 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A nonce value is a value that is not reused. **Nonce** means 'for the present time' or 'for a single occasion or purpose'. **Nonce** means 'for the present time' or 'for a single occasion or purpose'

(http://en.wikipedia.org/wiki/Nonce). The mentioned claims are indefinate due to the applicant's limitation that the nonce value is used or can be used for a limited number of times, i.e. more than once.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In making this determination, the examiner should consider and weigh the following factors:

(1) "USEFUL RESULT"

For an invention to be "useful" it must satisfy the utility requirement of section 101. The PTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP 2107. In addition, when the examiner has reason to believe that the claim is not for a practical application that produces a useful result, the claim should be rejected, thus requiring the applicant to distinguish the claim from the three exceptions to patentable subject matter by specifically reciting in the claim the practical application. In such cases, statements in the specification describing a practical application may not be sufficient to satisfy the requirements for section 101 with respect to the claimed invention. Likewise, a claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application. In other words, if the specification discloses a practical application of an abstract idea, but the claim is

broader than the disclosure such that it recites an abstraction, then the claim must be rejected.

(2) "TANGIBLE RESULT"

The tangible requirement does not necessarily mean that a process claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the process must be more than an idea, in that the process claim must set forth a practical application of that idea to produce a real-world result. Gottschalk v. Benson, 409 U.S. 63, 175 USPQ 673, 677 (1972) (invention ineligible because had "no substantial practical application."). "[A]n application of a law of nature or mathematical formula to a ... process may well deserving of patent protection." Diamond v. Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning v. Burden, 15 How. 252, 268, 14 L.Ed. 683 (1854) ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . ."). In other words, the opposite meaning of "tangible" is "abstract."

(3) "CONCRETE RESULT"

Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or

unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, because the invention cannot operate as intended without undue experimentation. *See infra.*

After the examiner identifies and explains in the record the basis for why a claim is for an abstract idea with no practical application, then the burden shifts to the applicant to either amend the claim or make a showing of why the claim is eligible for patent protection. See, e.g., Brana, 51 F.3d at 1566, 34 USPQ2d at 1441; see generally MPEP 2107 (Utility Guidelines). In addition, if an application is rejected under section 101 because there is reason to doubt the asserted utility, then the examiner should also reject the claims for lack of enablement, because a person skilled in the art cannot practice the invention. In re Swartz, 232 F.3d 862, 863 (Fed. Cir. 2000).

Claims 5, 16 and 27 are rejected under 35 U.S.C. 101 because the process of determining that the nonce value is valid and has been accepted for fewer than the specified number of requests is not tangible or concrete since it is not clear how this process is carried out.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-9, 16-20 & 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al., U.S patent 6,314,425, and further in view of Eldridge et al., 2002/0095570.

P = paragraph, i.e. p1 = paragraph 1.

As per claims 5, 16 & 27, Serbinis et al. discloses a method/system/computer readable medium of controlling access to data on a computer (abstract), the method comprising:

accepting a request for a data item, wherein the request contains a nonce value, wherein the nonce value comprises a token that Is only accepted for a specified (predetermined limit) (col.20, 16-25) number of requests (col.3, 57-67; col.4, 1-4; col.20, 16-25; The tokens are used to limit the user's access);

determining that the nonce value is valid (col.4, 66-67; col.5, 1-19; col.3, 57-67; col.4, 1-4; col.20, 16-25; Validating the token and limiting the amount of time the token can request to use the system/data.); and

responding to the request by returning the data item in response to the determining that the nonce value is valid (abstract; col.3, 57-67; col.4, 1-4; col.20, 16-25; Returning the data after the token has been validated and before the expiration time of the token, limiting the number of times the token can be used to request data from the system).

Serbinis does not disclose limiting the usage of the nonce (token) such that it has been accepted for fewer than the specified number of requests. Eldridge et al. discloses

limiting the usage of the nonce (token) such that it has been accepted for fewer than the specified number of requests (p8). It would have been obvious to modify Serbinis to include limiting the usage of the nonce (token) such that it has been accepted for fewer than the specified number of requests such as that taught by Eldridge et al. in order to avoid replay attacks (p8).

As per claims 6, 17 & 28, Serbinis et al. further discloses charging (billing) an entity in response to retuning the data item the step in conjunction with the use of the nonce (token) value (col.15, 30-38).

As per claims 7, 18 & 29, Serbinis et al. further discloses wherein the nonce (token) value comprises an expiration time and wherein the determining further determines that the nonce (token) value has not expired (col.21, 19-26).

As per claims 8, 19 & 30, Serbinis et al. further discloses wherein the determining that the nonce value is valid and accepted for fewer than the specified number of requests further comprises comparing the nonce value to a list of stored and valid nonce values (comparing the token to a list for validation) (col.21, 30-51).

As per claims 9, 20 & 31, Eldridge et al. and Serbinis et al. discloses wherein the list of stored and valid nonce values is shared with an entity that originated the data request (file sharing, and the token value (data) are in those files) (Eldridge et al.: p29, 31, 37 and 80-82) (Serbinis et al: abstract; col.2, 43-49).

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al., U.S patent 6,314,425 as applied to claim 5 above, and further in view of Khater, U.S. patent application publication 2002/0184143 or Pisarsky 2002/0147838.

As per claim 34, Serbinis et al. discloses a method/system/computer readable medium of controlling access to data on a computer as discussed above. Serbinis et al. does not disclose wherein the nonce value is only accepted one time, and wherein the responding to the request is performed in response to the nonce value having not been previously accepted (code/password can only be used once; request is only accepted one time). Khater or Pisarsky disclose wherein the nonce value is only accepted one time, and wherein the responding to the request is performed in response to the nonce value having not been previously accepted (code/password can only be used once; request is only accepted one time) (Khater, p16) (Pisarsky, p5). It would have been obvious to modify Serbinis et al. to include wherein the nonce value is only accepted one time, and wherein the responding to the request is performed in response to the nonce value having not been previously accepted (code/password can only be used once; request is only accepted one time) such as that taught by Khater or Pisarsky in order to reject any double usage of the code hence improving the security of the system since a after the code is used a new code has to be generated for the next request to go through the system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Corbin (U.S. patent 5,138,712) discloses an apparatus and method for licensing software on a network of computers.

Norris (U.S. patent 6,718,328) discloses a system and method for providing controlled and secured access to network resources.

Lau et al. (U.S. patent 6,182,124) discloses a token-based deadline enforcement system for electronic document submission.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Behrang Badii whose telephone number is 571-272-6879. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is **(571) 272-3600**.

Behrang Badii
Patent Examiner
Art Unit 3621

BB

PRIMARY EXAMINER